



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,947	01/03/2001	Ronald Pfaff	BEI-698-WG	8318

7590 11/13/2003

NORRIS, MCLAUGHLIN & MARCUS, P.A.  
220 EAST 42ND STREET  
30TH FLOOR  
NEW YORK, NY 10017

EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 7/31/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 9-20 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 9-15, 17-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 9-15 and 17-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -743 Patent Abstract or the complete German original taken in view of EPA -623, substantially for reasons of record, together with the following additional observations. To reiterate, since applicants in their response appear to be confused by the Examiner's reliance upon this particular grounds of rejection, it is again stated that the primary reference discloses substantially an anticipation of both the claimed electrically conductive adhesive film and the accompanying method for implanting electrical modules in a car body (applicants' claim 15) except for the absence of a teaching of silver coated glass beads being present in the disclosed adhesive composition, wherein the diameter of the glass beads is at least equal to the thickness of the adhesive film. The reference, however, in the original German further discloses (page 4, lines 1-2) that metal particles may be used to provide electrical conductivity in the adhesive composition (note also claim 3). The reference discloses the use of an adhesive film as being suitable for implanting electrical components in semiconductors in conjunction with powdered metals. The secondary reference EPA -623 discloses (note again particularly the Abstract, page 2 lines 15-36, page 4 line 37 - page 5 line 6,

Art Unit 1771

page 6 lines 9-23, page 7 lines 5-11) a transfer tape which contains electrically conductive particles such as silver which are preferably spherical and are larger than the thickness of the adhesive film between the particles. As such, a person skilled in the art would know that he could use silver particles having diameters which exceed the adhesive layer thickness in order to improve the electrical conductivity. Also, one of ordinary skill in the art would know the essential equivalents of electrical conductive particles such as silver and metal coated particles of non-conductive materials, for example silver coated glass beads from the disclosure (page 8, lines 21-28) of EPA -619, herein cited only as evidence of the state of the art. Accordingly, one of ordinary skill, motivated by the fact that the primary reference discloses that electrical conductivity may be enhanced by the use of metal particles in the adhesive film would naturally look to the disclosure of the closely related adhesive composition containing articles of the secondary reference, and thereby incorporate the silver particles taught therein into the adhesive layer films of the primary reference, and would further realize that silver coated glass bead particles would be equivalent to use and thereby form the claimed adhesive film and accompanying process. With respect to the dependent claims, these are once again believed to be, if not expressly or

Art Unit 1771

inherently disclosed obvious modifications to one of ordinary skill, in the absence of unexpected results.

3. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

Serial No. 09/720,947

-5-

Art Unit 1771

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

November 6, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1800~~  
1700

*Daniel Zinker*